

REMARKS/ARGUMENTS

In this response, Claims 1-2 and 13-14 have been amended. No claims have been canceled or added. Thus Claims 1-6 and 9-24 remain pending.

I. Rejection Under 35 U.S.C. § 112

Claims 1-6 and 9-24 are rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement as follows:

Applicant makes claim to a food grade insecticide which includes d-limonene. However, d-limonene according to the enclosed MSDS is harmful if ingested and therefore would not be considered a food grade ingredient as required by the limitation "food grade" of the instant claims.

Office Action, dated 5/18/06, at page 3. For the reasons set forth below, Applicant respectfully disagrees.

The MSDS states that a composition that comprises all of the following ingredients and in the following amounts is harmful if ingested: 93% d-limonene, 5% terpene, and 2% oxygenated terpenes. The MSDS does not indicate whether the toxicity of the composition is due to the presence of d-limonene, terpene, and/or oxygenated terpenes. Because Applicant's claimed invention contains from about 1% to about 24% d-limonene, the MSDS is not relevant to establish that d-limonene is not food-grade.

In fact, the MSDS supports Applicant's claim to a food-grade insecticide which includes d-limonene. On page 4 of the MSDS under "Regulatory Status," d-limonene is listed as

"GRAS-Generally Regarded As Safe" and is not listed as "carcinogenic to humans," "is NOT listed by EPA as hazardous waste," "is NOT listed on California's Prop. 65 toxic substance list," and is "NOT on EPA's CORR (Chemicals or Regulatory Rules) list, which contains those materials which pose a health or environmental risk."

In view of the foregoing discussion, Applicant submits that the rejection under § 112, first paragraph, be withdrawn. Reconsideration and withdrawal of the rejection is respectfully requested.

II. Rejections Under 35 U.S.C. § 103(a)

A. Claims 1-6, 9-11, 13-17, 22 and 23 over Dotolo in view of Van Tonder.

The Examiner rejected Claims 1-6, 9-11, 13-17, 22 and 23 under 35 U.S.C. § 103(a) as being obvious over Dotolo, U.S. Patent No. 4,379,168 ("Dotolo"), in view of Van Tonder, U.S. Patent No. 5,194,264 ("Van Tonder"). Examiner states:

Dotolo teaches all that is recited in the claims except for the invention comprising 1) a polyethoxylated castor oil and 2) amount (0.01-5%) of preservative. However, Van Tonder teaches an aqueous formulation comprising ectoparasites. See abstract, column 1 line 4-46. Van Tonder teaches that the composition may comprise one or more surfactants including polyethoxylated castor oil....It would have been obvious to one having ordinary skill in the art to modify the invention taught by Dotolo to include PEG-castor oil taught by Van Tonder. One would have been motivated to do this in order to enhance the consistency of the composition and because both inventions independently are to the control of lice on animals.

Office Action, dated 05/18/2006, at page 4. For the reasons set forth below, Applicant respectfully disagrees.

The Examiner has not identified a motivation in the prior art for combining Dotolo and Van Tonder. "When determining patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." In re Rouffet, 149 F.3d 1350, 1356, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of references taught every element of the claimed invention, however without a motivation to combine, a rejection based on *prima facie* case of obviousness was held improper). The Examiner states that "[o]ne would have been motivated to do this in order to enhance the consistency of the composition and because both inventions independently are to the control of lice on animals." However, neither reference identifies consistency of the composition as a desirable property. Moreover, there is nothing in the references that expressly or implicitly teach that polyethoxylated castor oil would enhance the consistency of the compositions or the control of lice on animals.

While Van Tonder identifies polyethoxylated castor oil as an optional component in the composition, it does not describe it as providing enhanced consistency or insect control. Furthermore, unlike the present invention, neither reference recognizes the need to provide a food-grade composition or the suitability of polyethoxylated castor oil for addressing that

need. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01; In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Furthermore, the factual inquiry as to combining references must be based on the objective evidence of record. In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). In Sang-Su Lee the Federal Circuit reversed a Board of Patent Appeals and Interferences finding of obviousness, holding that "[t]his factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." Id. at 1343-1344.

The combination of Dotolo and Van Tonder is improper because 1) there is no support for the proposition that polyethoxylated castor oil would provide enhanced consistency or improved insect control of the composition in Dotolo and 2) neither reference identifies consistency of the composition as a desirable property and thus there is no support that a need for consistency would have motivated one of ordinary skill in the art to combine Dotolo and Van Tonder.

In view of the foregoing discussion, Applicant submits that the § 103 rejection be withdrawn. Reconsideration and withdrawal of the rejection is respectfully requested.

**B. Claims 1-3, 6, 7, 9, 11-15, 20, 21, and 24 over Liebman
in view of Van Tonder.**

The Examiner rejected Claims 1-3, 6, 7, 9, 11-15, 20, 21, and 24 under 35 U.S.C. § 103(a) as being obvious over Liebman, Canadian Patent Application No. 2,060,594 ("Liebman"), in view of Van Tonder. Specifically, Examiner states:

Liebman teaches all that is recited in claims except for the invention comprising 1) a polyethoxylated castor oil and 2) instant amounts/ranges of ingredients: d-limonene, emulsifying agent, and hydrophilic solvent....It would have been obvious to one having ordinary skill in the art to modify the invention taught by Liebman to include PEG-castor oil taught by Van Tonder. One would have been motivated to do this in order to enhance the consistency of the shampoo and because both inventions independently are to the control of lice on animals. With respect to the amount/ranges of ingredients, one having ordinary skill in the art would have been expected to determine the optimum amounts/ranges of ingredients. One would have been motivated to do this in order to develop a lotion that would have been effective in killing lice, but yet non-toxic to animals being treated.

Office Action, dated 05/18/2006, at pages 5-6. For the reasons set forth below, Applicant respectfully disagrees.

Liebman discloses shampoo compositions comprising d-limonene. As Examiner concedes, Liebman does not disclose a formulation that includes polyethoxylated castor oil. While Liebman discloses the inclusion of "additional materials," none of these additional materials are disclosed as providing enhanced consistency of the shampoo. While Van Tonder identifies polyethoxylated castor oil as an optional component in the composition, Van Tonder does not describe polyethoxylated castor

oil as providing enhanced consistency.

Neither Liebman nor Van Tonder identifies consistency of the composition as a desirable property. Thus, for the same reasons set forth above, the Examiner has not identified a motivation in the prior art for combining Liebman and Van Tonder. Because there is no support for the proposition that a need for consistency would have motivated one of ordinary skill in the art to combine Liebman and Van Tonder, the combination is improper, and the rejection should be withdrawn.

Furthermore, unlike the present invention, neither reference recognizes the need to provide a food-grade composition or the suitability of polyethoxylated castor oil for addressing that need.

In view of the foregoing discussion, Applicant submits that the § 103 rejection be withdrawn. Reconsideration and withdrawal of the rejection is respectfully requested.

**C. Claims 1, 2, 6, 7, 9, 11-15, 17-19, 21, and 24
over Wilkins in view of Van Tonder.**

The Examiner rejected Claims 1, 2, 6, 7, 9, 11-15, 17-19, 21, and 24 under 35 U.S.C. § 103(a) as being obvious over Wilkins, Jr., U.S. Patent No. 5,951,992 ("Wilkins, Jr.") and Van Tonder. Specifically, Examiner states:

Wilkins, Jr. does not teach 1) the invention comprising a polyethoxylated castor oil and 2) the invention comprising instant amounts/ranges of ingredients: d-limonene, emulsifying agent, and hydrophilic solvent, 3) the plants being rose bushes and ornamentals....Van Tonder teaches that the composition may comprise one or more surfactants including polyethoxylated castor

oil....It would have been obvious to one having ordinary skill in the art to modify the invention taught by Wilkins, Jr. to include PEG-castor oil taught by Van Tonder. One would have been motivated to do this in order to enhance the consistency of the composition and because both inventions independently are to the control of pests on plants.

Office Action, dated 05/18/2006, at pages 6-7. For the reasons set forth below, Applicant respectfully disagrees.

Wilkins, Jr. discloses a pesticide formulations containing d-limonene. As Examiner concedes, Wilkins, Jr. does not disclose a formulation that includes polyethoxylated castor oil. Neither Wilkins, Jr. nor Van Tonder identifies consistency of the composition as a desirable property. Moreover, while Van Tonder identifies polyethoxylated castor oil as an optional component in the composition, it does not describe it as providing enhanced consistency or as providing improved insect control.

Thus, for the same reasons set forth above, the Examiner has not identified a motivation in the prior art for combining Wilkins, Jr. and Van Tonder. Because there is no support for the proposition that a need for consistency would have motivated one of ordinary skill in the art to combine Liebman and Van Tonder, the combination is improper, and the rejection should be withdrawn.

Furthermore, unlike the present invention, neither reference recognizes the need to provide a food-grade composition or the suitability of polyethoxylated castor oil for addressing that need.

In view of the foregoing discussion, Applicant submits that the § 103 rejection be withdrawn. Reconsideration and withdrawal of the rejection is respectfully requested.

III. Telephone Interview

Counsel for Applicant respectfully requests a telephone interview to discuss this response. Counsel for Applicant will be calling the Examiner shortly to schedule a telephone interview on a date and time that is convenient to the Examiner.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance.

Respectfully submitted,

JEFFER, MANGELS, BUTLER & MARMARO LLP

Dated: September 18, 2006

By: 

Michelle C. Kim, Esq.
Reg. No. 51,881
1900 Avenue of the Stars
Seventh Floor
Los Angeles, CA 90067-4308
(310) 203-8080